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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,053	07/26/2001	William John Waywood	A1019/20276	7279

7590

05/10/2004

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -2- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 3/5/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 3-6, 8-28, 30-33, 35-50 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1, 3-6, 8-28, 30-33, 35-50 is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The amendment filed March 5, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: applicant's cancellation of the entire paragraph beginning at page 3, line 7 of the specification which contained an amended admission regarding the state of the prior art clearly constitutes new matter. Applicant again argues (e.g., page 6, top paragraph) that the amendment presented to the specification, namely the cancellation of the paragraph which contained admissions regarding the state of the prior art is "simply an amendment to correct the scope of the prior art" but by doing so he also changed the scope of his earlier admission, which the Examiner had previously relied upon, in combination with the secondary reference Frognet et al. to reject his claims as being obvious. The Examiner again repeats his position that it is a well known fact that the specification cannot be amended during any point in the prosecution (which includes a RCE application) to incorporate new matter even in situations when the material which is deleted may well be factually incorrect as regards the

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status of the prior art, and the material added is also a correct statement of the prior art, as applicant has previously strongly urged. The fact that applicant has cancelled from the application the entirety of the amended paragraph which was previously objected to by the Examiner, and has presented the prior art information in a new Supplemental Information Disclosure Statement accompanying this amendment is simply irrelevant. Applicant's further contention that the cancellation of the paragraph describing the status of the prior art does not constitute new matter since it does not in any way alter the description or breadth of the invention being claimed (Response, page 3, third complete paragraph) is also incorrect. Nowhere has the Examiner ever held during the prosecution that applicant's specification was ever non-enabling to one of ordinary skill, and applicant's remarks (e.g., Response page 4, top paragraph) which clearly imply that such is the case is simply incorrect.

With respect to applicant's continuing reliance upon the Board of Patent Appeals and Interferences unpublished opinion Ex Parte Anderson et al., the Examiner again notes that the factual situation in that case was much different than that of the present application. In that application it appears that there was a clearly discernible factual error in the technical disclosure, which was easily correctable, while in the present

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application applicant has made a far from obvious incorrect statement regarding the state of the prior art of which he was aware, which is believed more than sufficient to distinguish the two cases.

Applicant is required to cancel the new matter in the response to this Office action.

3. Claims 1,3-6, 8-28, 30-33 and 35-50 are allowed. The Examiner, however, notes that if the new matter based 35 USC 132 objection set forth above is overcome by the reinsertion of the originally presented paragraph set forth at page 3, line 7 of the specification the Examiner will again present the original prior art rejection based upon applicant's admissions taken in view of Frognet et al to reject all of the pending claims, and in essence deny applicant a patent.

4. This application is in condition for allowance except for the following formal matters:

The Objection based upon 35 USC 132 as set forth above, but see Paragraph 3, above.

Prosecution on the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

May 6, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300 1700

*Daniel Zirker*